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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,071	07/08/2003	Dirk J. Rettig	52.061	7880
23598	7590	03/22/2005	EXAMINER	LUONG, VINH
BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C. 250 E. WISCONSIN AVENUE SUITE 1030 MILWAUKEE, WI 53202			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	<b>Application No.</b> 10/615,071	<b>Applicant(s)</b> RETTIG, DIRK J.
	<b>Examiner</b> Vinh T Luong	<b>Art Unit</b> 3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 28 February 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-16 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 08 July 2003 is/are: a)  accepted or b)  objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: *Attachment*.

1. Applicant's election without traverse of Group I in the reply filed on February 28, 2005 is acknowledged.
2. Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 28, 2005.
3. The drawings are objected to because, e.g., (a) the various parts in Fig. 5 should be embraced by a bracket in order to show their relationship; and (b) the drawings must not use the same referential numeral to indicate different things or *vice versa*. For example, Applicant uses the same referential numeral 60 to indicate the first upper member and the first lower member. Applicant is respectfully suggested to change to, e.g., 60 and 60'.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Claims 1-16 are objected to because of the following informalities: (a) no antecedent basis is seen for the term such as “the bicycle” in claims 1 and 13; and (b) the claims contain typographical or grammatical error, e.g., “the number of tabs *are* positioned” in claim 3 should have been “the number of tabs *is* positioned.” Appropriate correction is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms such as “securable” and “rotatable” in claim 1, “securable” and “positionable” in claim 13, and “engageable” in claims 13 and 14 are vague and indefinite in the sense that things which may be done are not required to be done, e.g., in claim 1, the first spacer is *securable*, but is not required structurally to be secured to the steer tube on one side of the stem. See “crimpable” and “discardable” in *Mathis v. Hydro-Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986); “removable” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992) and “comparable” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

It is unclear whether a confusing variety of terms such as “a bicycle handlebar stem” and “a handlebar stem” in claim 13 refer to the same or different things. See MPEP 608.01(o) and 2173.05(o).

The term “rigid” in claim 12 is a relative term which renders the claim indefinite. The

term "rigid" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear, e.g., what range of Rockwell hardness of the material is required in order to be "rigid material."

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-16, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chi (DE 199 40 969 A1 cited in the restriction on January 27, 2005).

Regarding claim 1, Chi teaches a height adjustment assembly for a bicycle handlebar stem 91 that is positioned on a steer tube 8 of a bicycle, the height adjustment assembly comprising a first spacer (Fig. 1) *securable* to the steer tube 8 on one side of the stem 91 and including a first upper member 21 and a first lower member 22, each of the first upper member 21 and the first lower member 22 including a base (e.g., at 21 in Fig. 1. See Attachment) and a number of tabs (Att.) extending outwardly from one side of the base, each of the number of tabs

(Att.) including a plurality of locking members 221, 221 positioned on the tab (Att.), wherein the first upper member 21 is rotatable with respect to the first lower member 22 to selectively engage the locking members 211 on the first upper member 21 with the locking members 221 on the first lower member 22 in various configurations. See English translation.

Chi teaches the invention substantially as claimed. Particularly, Chi apparently teaches one spacer instead of two spacers (first and second spacers). Moreover, Chi's spacer is inherently *securable* to the steer tube 8 on one side of the stem 91 or on the opposite side of the stem 91.

It is common knowledge in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem. The use of one spacer or two spacers on opposite sides of the stem would have been an obvious choice in design since the claimed structure and the function it performs are the same as the prior art. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) and *Sjolund v. Musland*, 6 USPQ2d 2020, 2026 (CAFC)(the use of a plurality of panels instead of a single panel is obvious).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem as taught or suggested by common knowledge in the art.

Regarding claim 2, the base (Att.) is generally circular in shape.

Regarding claim 3, the number of tabs (Att.) is positioned in an abutting relationship with one another around the base (Att.).

Regarding claim 4, each of the number of tabs (Att.) has an upper end (Att.) and a lower end (Att.).

Regarding claim 5, each of the tabs (Att.) has a sloped surface (Att.) extending from the upper end (Att.) to the lower end (Att.).

Regarding claim 6, the plurality of locking members 211, 221 are disposed on the sloping surface (Att.).

Regarding claim 7, the plurality of locking members 211, 221 are formed as a number of teeth extending from each of the number of tabs (Att.) opposite the base (Att.).

Regarding claim 8, see a plurality of grooves (Att.) disposed between adjacent pairs of the number of teeth (Att.).

Regarding claim 9, one of the first upper member 21 or the first lower member 22 is *adapted to be* fixedly attached to the steer tube 8 (Figs. 3-5). It has long been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 U.S.P.Q. 138 (CCPA 1946).

Regarding claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the second spacer being identical to Chi’s first spacer in order to adjust the height of the bicycle handlebar stem, *i.e.*, the second spacer is formed of a second upper member and a second lower member, each of the second upper member and the second lower member including a base and a number of tabs extending outwardly from one side of the base, each of the number of tabs including a plurality of locking members positioned on the tab. See regarding claim 1, *In re Chu and Sjolund v. Musland, supra*.

Regarding claim 11, one of the second upper member 21 and the second lower member 22 is adapted to be fixedly attached to the steer tube 8. *In re Hutchison, supra.*

Regarding claim 12, the first upper member 21 and the first lower member 22 are formed from a rigid material (metal as seen by the drawing symbols for draftsperson in Fig. 2).

Regarding claim 13, Chi teaches a height adjustment assembly for a bicycle handlebar stem 91 that is positioned on a steer tube 8 of the bicycle, the assembly comprising a first spacer 21, 22 securable to the steer tube 8 and including a first upper member 21 and a first lower member 22, each of the first upper member 21 and the first lower member 22 including a base (Att.) and a number of tabs (Att.) extending outwardly from one side of the base (Att.), each of the number of tabs (Att.) including a plurality of locking members 211, 221 positioned on the tab (Att.), the locking members 211 on the first upper member 21 engageable with the locking members 221 on the first lower member 22, and a handlebar stem 91 releasably securable to the steer tube 8, wherein the first upper member 21 is rotatable with respect to the first lower member 22.

Chi teaches the invention substantially as claimed. Particularly, Chi apparently teaches one spacer instead of two spacers (first and second spacers). Moreover, Chi's spacer is inherently *securable* to the steer tube 8 on one side of the stem 91 or on the opposite side of the stem 91.

It is common knowledge in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem. The use of one spacer or two spacers on opposite sides of the stem would have

been an obvious choice in design since the claimed structure and the function it performs are the same as the prior art. *In re Chu and Sjolund v. Musland, supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem as taught or suggested by common knowledge in the art.

Regarding claim 14, see regarding claim 10 above.

Regarding claim 15, see regarding claim 1 or 13 above.

Regarding claim 16, the first lower member 21 and second upper members 22 are *adapted to* be fixedly attached to the steer tube 8. *In re Hutchison, supra*.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: To (abstract), Sparrow et al. (spacer 222, 254, etc.), Couturet (Figs. 1-4), Chen (Fig. 1), Ressort (spacer 10), and Chi'585 (spacer 42).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

March 18, 2005



Vinh T. Luong  
Primary Examiner

# ATTACHMENT

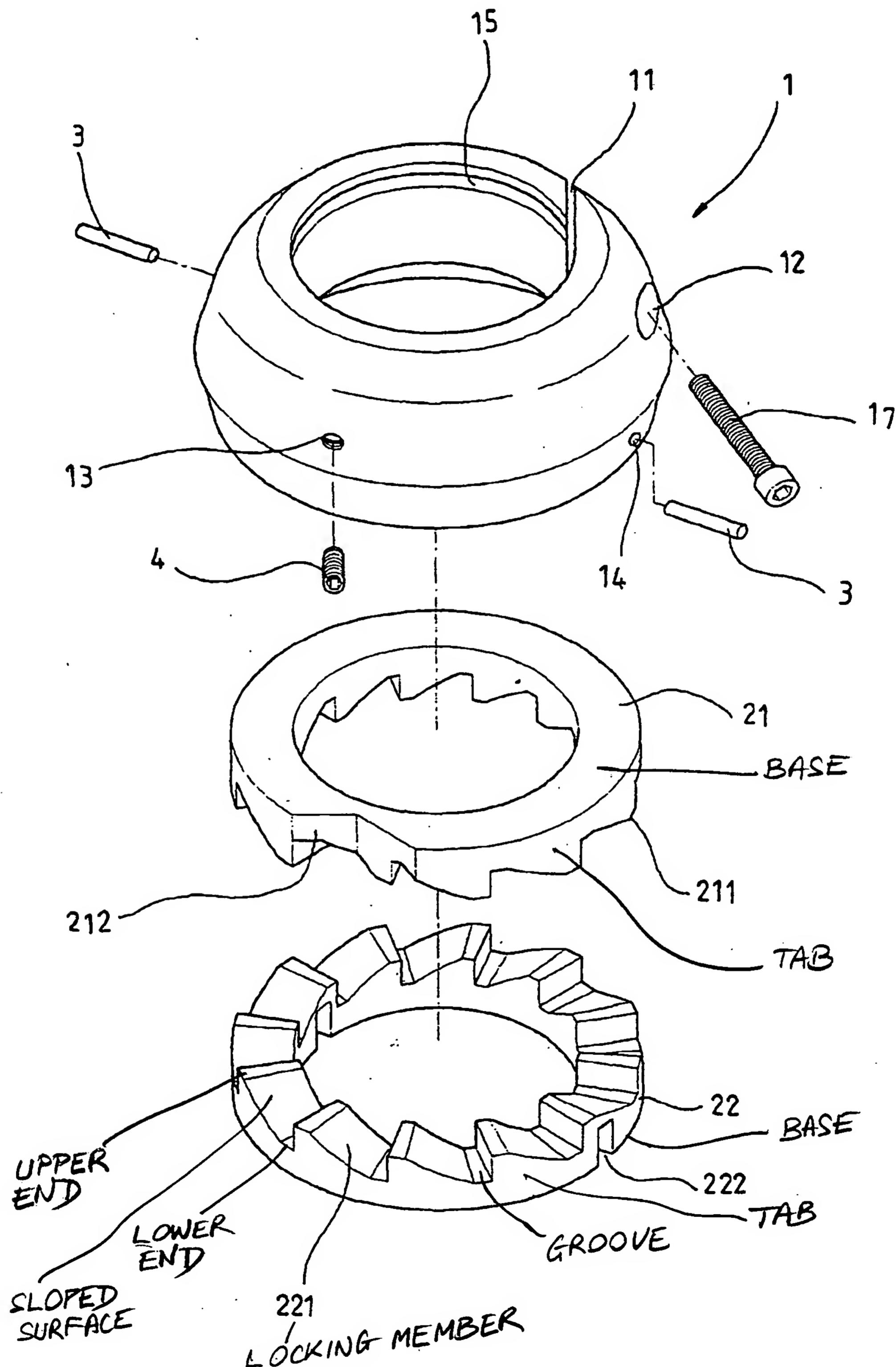


FIG.1